**THIS OPINION WAS NOT WRITTEN FOR PUBLICATION**

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper 12

Filed by: Trial Section
Box Interference
Washington, D.C. 20231
Tel: 703-308-9797
Fax: 703-305-0942

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

---

ANDREAS WINTER, MARTIN ANTBERG, BERND BACHMANN, VOLKER DOLLE, FRANK KUBER, JURGEN ROHRMANN and WALTER SPALECK

Junior Party,
(Patent 5,693,836),

v.

EBERHARD KARL, WERNER ROELL, HANS BRINTZINGER, BERNHARD RIEGER and UDO STEHLING,

Senior Party
(Application 08/642,491)

---

Patent Interference No. 104,447

---

Before: McKELVEY, Senior Administrative Patent Judge, and LEE and TORCZON, Administrative Patent Judges.

McKELVEY, Senior Administrative Patent Judge.

**FINAL JUDGMENT**

**A. Conference call**

A telephone conference call was held on 17 November 1999, at approximately 9:30 a.m., involving:

(1) Ashley I. Pezzner, Esq., counsel for Winter;

(2) Malcolm J. McDonald, Esq., counsel for Karl; and

(3) Fred E. McKelvey, Senior Administrative Patent Judge.

**B. Discussion**

The purpose of the conference call was to discuss the status of the interference. Karl did not file a list of any preliminary motion to be filed. Winter indicated that it might file a preliminary motion to add a reissue (Paper 11, page 2). Mr. Pezzner explained that the purpose of the reissue application would be to obtain claims which are patentably distinct from the count. The parties were advised that the board has determined that it will not add reissue applications to interferences under 37 CFR § 1.633(h) unless all new claims (as opposed to original patent claims) are to be designated as corresponding to the count. Winter v. Fujita, Interference 104,283 (Bd. Pat. App. & Int. Nov. 16, 1999) (Paper 73) (copy attached). It is manifest, based on the discussion during the conference call, that Winter would seek to file a reissue with narrower claims which Winter would

not have sought to have designated as corresponding to the count.

Apart from the interference, Winter may file an application to reissue the Winter patent involved in the interference. If the claims sought to be obtained in the reissue application are directed to an invention which is patentably distinct from the count, a reissue patent containing those claims may be issued. Cf. In re Deckler, 977 F.2d 1449, 24 USPQ2d 1448 (Fed. Cir. 1992) (junior party losing interference to senior party based on senior party's foreign priority date is not entitled to claims to same patentable invention as count--based on estoppel); Ex parte Tytgat, 225 USPQ 907 (Bd.App. 1985).

After a discussion of the status of the interference, it became apparent that Winter did not urge a basis upon which it might prevail. Hence, entry of a final decision at this time is appropriate. Entry of a final decision, however, will be without prejudice to Winter filing a reissue application and to obtaining a reissue application with claims which are patentably distinct from the count.

**C. Order**

Upon consideration of the record, it is

ORDERED that judgment on priority as to Count 1, the sole count in the interference, is awarded against junior party Andreas Winter, Martin Antberg, Bernd Bachmann, Volker Dolle, Frank Kuber, Jurgen Rohrmann and Walter Spaleck.

FURTHER ORDERED that judgment on priority as to Count 1 is awarded in favor of senior party Eberhard Karl, Werner Roell, Hans Brintzinger, Bernhard Rieger and Udo Stehling.

FURTHER ORDERED that, on the record before the Board of Patent Appeals and Interferences, senior party Eberhard Karl, Werner Roell, Hans Brintzinger, Bernhard Rieger and Udo Stehling is entitled to a patent containing claims 11-17 (corresponding to Count 1) of application 08/642,491, filed May 3, 1996.

FURTHER ORDERED that junior party Andreas Winter, Martin Antberg, Bernd Bachmann, Volker Dolle, Frank Kuber, Jurgen Rohrmann and Walter Spaleck is not entitled to a patent containing claims 1-3 (corresponding to Count 1) of U.S. Patent 5,693,836, granted 6 December 1997, based on application 08/484,457, filed 7 June 1995.

FURTHER ORDERED that entry of this FINAL JUDGMENT is without prejudice to Winter filing an application to reissue

the Winter patent involved in the interference to seek to obtain claims which are patentably distinct from Count 1.

FURTHER ORDERED that if there is a settlement agreement, attention is directed to 35 U.S.C. § 135(c) and 37 CFR § 1.661.

| | |
|---|---|
| FRED E. McKELVEY, Senior<br>Administrative Patent Judge | ) |
| JAMESON LEE<br>Administrative Patent Judge | ) BOARD OF PATENT<br>) APPEALS AND<br>) INTERFERENCES |
| RICHARD TORCZON<br>Administrative Patent Judge | ) |

cc (via First Class Mail):

Attorney for Winter
(real party in interest
Targor GmbH [Targor GmbH is a
joint venture between Hoechst AG and BASF):

Rudolf E. Hutz, Esq.
Ashley I. Pezzner, Esq.
CONNOLLY, BOVE, LODGE & HUTZ
1220 Market Street
Wilmington, DE 19899

Tel: 302-658-9141
Fax: 302-658-5614
E-mail: aip@cblhlaw.com
E-mail: tmm@cbhllaw.com

Attorney for Karl
(real party in interest
BASF Aktiengesellschaft):

Herbert B. Keil, Esq.
Ronald H. Smith, Esq.
Norman G. Torchin, Esq.
KEIL & WEINKAUF
Suite 620
1101 Connecticut Avenue, N.W.
Washington, D.C. 20036

Tel: 202-659-0100
Fax: 202-659-0105